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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,154	01/12/2007	Takayoshi Kawamura	450106-05231	9464

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EXAMINER
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NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

MAIL DATE	DELIVERY MODE
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10/05/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/560,154	<b>Applicant(s)</b> KAWAMURA ET AL.	
	<b>Examiner</b> MAIKHANH NGUYEN	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the RCE filed 02/12/2010.

Claims 9-12 are currently pending in this application. Claims 9-12 have been amended.

Claims 9-12 are independent Claims.

### **Request Continuation for Examination**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/12/2010 has been entered.

### **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

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*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Regarding independent Claim 9**, the claim recites an “information processing apparatus” comprising “means for identifying,” “means for generating,” and “means for reading.” As currently recited the “information processing apparatus” comprises only computer software elements. Thus, the recited “information processing apparatus” is computer software *per se* and is not a “process,” a “machine,” a “manufacture” or a “composition of matter,” as defined in 35 U.S.C. 101.

Accordingly, the recited information processing apparatus is nonstatutory subject matter.

**Regarding independent Claim 10**, the claim recites a method comprising steps that may be performed manually and/or mentally. Thus, the recited method is not tied to a particular machine or apparatus. Additionally, none of the recited steps transform a particular article into a different state or thing.

Accordingly, the recited method is nonstatutory subject matter.

### Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

*This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Koyama** (US 6112010, issued 08/29/2000) in view of **Kato et al.** (US 7236687, filed 04/20/2001).

#### **As to Claim 9:**

Koyama teaches an information processing apparatus that processes a plurality of pieces of data recorded on a record medium (See Col. 1, line 56 – Col. 2, line 27: *the picture recording apparatus according to this invention electrically handles still pictures as picture data ... reading pictures (pictorial images) recorded on photographs or books, etc., video tape recorder equipment for reproducing still pictures recorded on a video tape to input them, optical disc reproducing (playback) equipment for reproducing still pictures recorded on an optical disc*), comprising the steps of:

- identification means for identifying encoding systems for the plurality of pieces of data in an edit for which they are connected and successively reproduced (See Col. 6, lines 17 – 65: *management file for carrying out management of correspondence information between respective files in the plurality of picture files, and management information for carrying out, in predetermined recording units of the recording medium, relative position on the recording medium between the management file and the picture file... a data management structure to designate a desired picture file from the plural picture files having different resolutions on the basis of management data of the management file to designate position on the recording medium within the picture file designated by the management file on the basis of the management data of the management information... since management information for designating picture file are all recorded within the management file, even in the case where correspondence state (situation) between picture files and the display order of pictures are changed by editing operation*; See also, Col. 22, line 60 - Col. 26, line 5 and Col. 66, lines 45 – Col. 68, line 36); and
- determination means for reading the management information file generated by the generation means and recorded on the recording medium and determining reproducibility of all the plurality of pieces of data according to the group name contained in the management information file when the plurality of pieces of data are reproduced as the result of the edit (See Col. 63, lines 34-64: *the system controller 6 controls the disc recording/reproducing section 5c so as to read out*

*all management files (overall information management file, picture data management files of respective directories, print control data management file, reproduction control management file) through the storage section controller 5d, and temporarily stores, into the RAM 6a, the all management files which have been read out... it is necessary to display what picture data are recorded in respective directories to cause the user to designate desired picture. For this reason, at the step S128, the system controller 6 controls the disc recording/reproducing section 5c so as to display overall index file recorded on the optical disc 20. Thus, the processing operation proceeds to step S129. The overall index file is a file in which index picture data which are the same as an arbitrary one index picture of index picture data stored in the picture index files below (at the lower level of) respective picture directories are registered in display order of monitor. By monitor-displaying the overall index file, the user can carry out designation of desired index picture; see Col. 68, lines 1-7 → At the step S160, the system controller 6 controls the disc recording/reproducing section 5C so as to read out data U\_ TOC, overall information management file and picture data management file in the RAM 6a to write them onto the disc to thereby update the respective data. Thus, the entire routine according to the editing operation of picture is completed; see also, Figs. 38 and 46).*

Koyama does not teach the following limitations:

Kato teaches generation means for generating one management information file that manages the result of the edit so that the management information file contains a group name representing each of the plurality of encoding systems of the plurality of pieces of data that were used when the management information file was edited to and recording the management information file in a directory of the recording medium attachable and detachable to and from the information processing apparatus, the directory for the management information file being different from other directories of the recording medium (See Col. 8, line 59 – Col. 16, line 9 and Col. 38, line 1- Col. 50, line 41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Koyama with Kato because it would have provided the enhanced capability for encoding picture data to execute an encoding step of encoding the picture data at a variable rate, and a controlling step of managing control so that the amount of picture coding data will be substantially proportionate to the time elapsed.

**As to Claim 10:**

Refer to the discussion of Claim 9 above for rejection. Claim 10 is the same as Claim 9, except Claim 10 is an information processing method Claim and Claim 9 is an information processing apparatus Claim.



**As to Claim 11:**

Refer to the discussion of Claim 9 above for rejection. Claim 11 is the same as Claim 9, except Claim 11 is a recording medium Claim and Claim 9 is an information processing apparatus Claim.

**As to Claim 12:**

Refer to the discussion of Claim 9 above for rejection. Claim 12 is the same as Claim 9, except Claim 12 is a program Claim and Claim 9 is an information processing apparatus Claim.

**Response to Arguments**

5. Applicant's arguments filed 02/12/2010 have been fully considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

6. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified

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reference carefully before responding to this office action to properly advance the case in light of the prior art.

### **Contact information**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MaiKhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MaiKhanh Nguyen/

Examiner, Art Unit 2176